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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,443	10/12/2001	Ronald E. Sloan	60021.376002	2727

29838 7590 03/29/2005

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EXAMINER
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SHAH, ANKEETA

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,443

Applicant(s)

SLOAN ET AL.

Examiner

Ankeeta Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/26/2004, 01/05/04, 02/17/04
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-24 been canceled.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran(US PAT 6,430,542) in view of Maggioncalda et al. (hereafter Maggioncalda, US PAT 5,918,217)

**Re Claim 25,32 and 37:** Moran discloses a system and method for providing automated coaching for a financial modeling and counseling system over a network to a user, comprising:

inputting personal financial data of a user (see col11, lines 41-43);

inputting user preferences (claims 1-6).,

inputting user financial goals (see col11, lines 45-46);

inputting external financial market data (claims 1-6);

processing the personal financial data, the external financial market data, the user

outputting automated coaching advice presented in a natural language format, wherein

the automated coaching advice includes a proposed product configuration formulated to

comply with the user preferences and the user financial goals; and a projection of an effect of the proposed product configuration on attaining the user financial goals (method steps of figs. 3-39); wherein part of the personal financial data includes an aggregated cash flow model, an investment target value, a target date for achieving financial user Financial goals (fig.42);

Moran does not disclose: wherein the proposed product configuration includes recommended securities for the user to purchase.

Maggioncalda discloses: the system being used by the user directly (see Fig1) and wherein the proposed product configuration includes recommended securities for the user to purchase (see Col10, lines 20-30 and Fig 5A).

Thus it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Moran by adapting the teaching of Maggioncalda so as to guide the user into a more elaborate profit making advice.

**Re Claim 26,33 and 38:** Moran discloses: The method, system and computer program, wherein part of the personal financial data includes an aggregate cash flow model, an investment value, a target date for achieving financial user financial goals, or an investment portfolio (see abstract).

**Re Claim 27,34 and 39:** Moran does not disclose: The method, system and computer program, wherein the financial market data includes values of various market benchmark indices, performance history of various securities, or prices of various securities;

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Maggioncalda discloses: The method, system and computer program, wherein the financial market data includes values of various market benchmark indices, performance history of various securities (i.e. the volatility), or prices of various securities (see abstract);

Thus it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Moran by adapting the teaching of Maggioncalda so as to guide the user into a more elaborate profit making advice.

**Re Claim 28,35 and 40:** Moran discloses: The method, system and computer program wherein the automated coaching advice in natural language format is an interpretation of numerical data (see col 25, lines 52-55).

**Re Claim 29 and 41:** Moran discloses: The method wherein the user preferences include a risk tolerance, an investment style, or a market attitudes (see Fig.30, 87).

**Re Claim 30:** Moran discloses: The method wherein the user goals include retirement, purchasing a house, purchasing a car, going on vacation, or paying for college (see Fig 18).

**Re Claim 31 and 36:** Moran discloses: The method wherein the automated coaching advice provides live coaching over the network (see col2, lines 16-19).

### ***Response to Arguments***

4. Applicant's arguments filed December 08, 2004 have been fully considered but they are not persuasive.

a. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., intended to be used directly by the user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further the system of Moran can be clearly used by the user directly to save the user expenses.

b. In response to applicants argument that Moran does not disclose recommending securities for a user, a new ground of rejection is made Moran in view of Maggioncalda

### CONCLUSION

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703)305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703)308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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